Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER T. O'HEERON,
TERRY L. BOHANNON
and PATRICK T. DAVIS

Appeal No. 2003-1171
Application 09/809,648

ON BRIEF

Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Peter T. O'Heeron et al. appeal from the final rejection of claims 1 through 5, all of the claims pending in the application.

THE INVENTION

The invention relates to "surgical instruments known as trocars which are used in endoscopic surgery to pierce or puncture an anatomical cavity to provide communication with the cavity during a surgical procedure" (specification, page 1).

Representative claim 1 reads as follows:

1. A trocar, comprising:
a. a body assembly;
b. a cannula assembly attached to the body assembly to define a bore therethrough; and
c. an obturator assembly for sliding engagement in the bore, which obturator assembly comprises: (i) a shaft having a distal end for insertion into a patient, where the distal end of the obturator has a tip which is non-conical and which has an upper face and a lower face which taper from the shaft to form a V-shaped distal end of the tip; and (ii) wing elements which are located between the upper and lower faces proximate the distal end of the obturator which are spaced approximately 180 degrees from one another.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Danks et al. (Danks)	5,545,150	Aug. 13, 1996
Wolf et al. (Wolf)	5,810,863	Sep. 22, 1998
Dunlap et al. (Dunlap)	5,941,852	Aug. 24, 1999

THE REJECTIONS

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Danks.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Danks in view of Wolf.

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dunlap.

Attention is directed to the main and reply briefs (Paper Nos. 6 and 9) and to the answer (Paper No. 7) for the respective

positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1 and 3 as being anticipated by Danks

Danks discloses a trocar (see Figures 6A and 6B) comprising a housing 40, a cannula tube 84 attached to the housing and defining a bore therewith and an obturator 12 for sliding engagement in the bore. The obturator includes a hollow sheath 18, a piercing tip 80 on the distal end of the sheath and a shield 15 slidably disposed within the sheath. The piercing tip 80 consists of a substantially planar pointed blade 81 having a sharp tip 87 and straight sharpened edges 91, and the shield 15 consists of a "bottle shaped" distal end 51 having a blunt distal end 92 and opposed slightly concave surfaces 94 which taper inwardly toward the blunt end. The shield 15 moves between a fully extended position completely covering the piercing tip (Figures 7A and 7B), a partially retracted position covering part of the piercing tip (Figures 8A and 8B), and a fully retracted position completely exposing the piercing tip (Figures 9A and 9B).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency,

each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In finding that the subject matter recited in claim 1 is anticipated by Danks, the examiner reads the claim limitations relating to the body assembly, cannula assembly and obturator assembly on Danks' housing 40, cannula tube 84,[1] and obturator 12, respectively.

As framed and argued by the appellants, the dispositive issue with respect to the rejection is whether Danks meets the obturator assembly limitations requiring the distal end of the obturator to have a tip which is non-conical and has an upper face and a lower face which taper to form a V-shaped distal end of the tip and wing elements located between the upper and lower

[1] On page 3 in the answer, the examiner inaccurately identifies the cannula tube as element 14.

faces proximate the distal end of the obturator and spaced approximately 180 degrees from one another. According to the examiner, Danks' blade 81 and shield distal end 51 together constitute an obturator distal end tip which is non-conical and has upper and lower faces in the form of shield surfaces 94 which taper to form a V-shaped distal end of the tip and wing elements in the form of blade edges 91 located between the upper and lower faces proximate the distal end of the obturator and spaced approximately 180 degrees from one another. The appellants counter that Danks' obturator tip does not include any part of the shield 15 and is limited to the blade 81, and as such does not embody upper and lower faces and wing elements as recited in claim 1.

Claim 1 does not include any obturator tip limitation which excludes or is otherwise inconsistent with Danks' shield 15. In this regard, and notwithstanding the appellants' arguments to the contrary, the claim does not call for the obturator tip to be a blunt piercing tip. As illustrated in Figures 8A and 8B, Danks' blade 81 and shield distal end 51 collectively form an obturator distal end tip which is non-conical. Shield surfaces 94 comprise upper and lower faces tapering to form a V-shaped distal end of the tip. Blade edges 91, which are spaced 180 degrees from one

another, comprise wing elements located between the upper and lower faces proximate the distal end of the obturator under the conventional definition of the term "wing" advanced by the appellants: "a part or feature usu. projecting from and subordinate to the main or central part" (reply brief, page 3).

Hence, the appellants' position that the obturator tip limitations in claim 1 distinguish the claimed trocar over that disclosed by Danks is not well taken. We shall therefore sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Danks.

We also shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claim 3 as being anticipated by Danks since the appellants have not challenged such with any reasonable specificity, thereby allowing this claim to stand or fall with parent claim 1 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

II. The 35 U.S.C. § 103(a) rejection of claim 5 as being unpatentable over Danks in view of Wolf

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 5 as being unpatentable over Danks in view of Wolf since the appellants have not challenged such with any reasonable specificity, thereby allowing this claim to stand or fall with parent claim 1 (see Nielson, supra).

II. The 35 U.S.C. § 102(b) rejection of claims 1, 2 and 4 as being anticipated by Dunlap

Dunlap discloses a trocar 10 comprising a handle 134, a cannula tube 132 attached to the handle and defining a bore therewith and an obturator 12 for sliding engagement in the bore. The obturator includes a hollow shaft 18, a piercing tip 16 on the distal end of the shaft and shield members 52, 54 and 56 slidably disposed within the shaft. Dunlap describes and illustrates the structural details of the piercing tip 16 and shield members 52, 54 and 56 at column 8, line 22, through column 11, line 42, and in Figures 10 through 10D.

As indicated above, claim 1 recites a trocar comprising, inter alia, an obturator tip having wing elements spaced approximately 180 degrees from one another. In determining that this limitation is met by Dunlap, the examiner refers to the blunted land 51 (see Figures 10B, 10C and 10D) which is one of three blunted lands 51, 53 and 55 respectively located on three interior shaft walls 40, 42 and 44 spaced at 120 degree intervals, and to Dunlap's disclosure at column 8, lines 49 through 53, that other quantities of interior walls, i.e., one, two, four, etc., could be employed. Presumably, the examiner considers that one or more of these alternative constructions would define two blunted lands or wing elements spaced 180

degrees from one another. To the extent that this is the examiner's position, it is unduly speculative as the reference lacks adequate factual support therefor.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) of claim 1, and dependent claims 2 and 4, as being anticipated by Dunlap.

SUMMARY

The decision of the examiner to reject claims 1 through 5 is affirmed with respect to claims 1, 3 and 5 and reversed with respect to claims 2 and 4.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JOHN P. MCQUADE Administrative Patent Judge	)	
	)	BOARD OF PATENT
	)	APPEALS AND
JEFFREY V. NASE Administrative Patent Judge	)	INTERFERENCES
	)	
JENNIFER D. BAHR Administrative Patent Judge	)	

JPM/kis

JACKSON WALKER, L.L.P.
SUITE 2100
112 EAST PECAN STREET
SAN ANTONIO, TX 78205